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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/189,410	11/10/1998	MINORU KURIKI	826.1517/JDH	5479

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EXAMINER

CALDWELL, ANDREW T

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/16/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

*[Handwritten signature]*

**Office Action Summary**

Application No.

09/189,410

Applicant(s)

KURIKI ET AL.

Examiner

Andrew Caldwell

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**Part III DETAILED ACTION**

***Remarks***

1. Claims 1-27 are presented for examination.

***Claim Objections***

2. Claim 2 and 7 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter of the invention. As to claim 2, there is no antecedent basis for the message at line 4. For purposes of prior art rejections in this Office action, the message will be construed as referring to the interpersonal message. As to claim 7, there is no antecedent basis for the transmitted message at line 6.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-12 and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Swenson et al., U.S. Patent No. 5,490,097.
5. Regarding claim 1, Swenson anticipates the claimed invention by disclosing an apparatus comprising:

a. A message management unit (Fig. 3 elems. 84, 86, 88 viewers) enabling a user at each of said plurality of terminals (Fig. 3 elems. 84a, 86a, 88a) to compose interpersonal messages and to view and respond to received interpersonal messages respectively (Col. 11 lines 19-24);

b. A preparation unit (Fig. 3 elem. 80a) preparing a receiver state list indicating states of a plurality of receivers of an interpersonal message that is managed by said message management unit (Col. 8 lines 29-31; Col. 16 lines 36-54; Col. 17 lines 53-65).

6. Regarding claim 2, Swenson teaches a message processing apparatus wherein the receiver state list includes completion information indicating whether the receivers have viewed the interpersonal message or whether the receivers have completed business activities related to a content of the message (Col. 16 lines 44-54).

7. Regarding claim 3, Swenson teaches a message processing apparatus wherein the message management unit enables the content of the interpersonal message and the receiver state list corresponding to the message to be displayed on a terminal screen in an associated manner (Col. 17 lines 4-9).

8. Regarding claim 4, Swenson teaches a message processing apparatus wherein the receiver state list includes:

a. Open information indicating open states of the interpersonal message of the plurality of receivers (Col. 16 lines 44-54 "active" as open information);

b. Completion information indicating whether the receivers have viewed the interpersonal message or whether the receivers have completed business activities related to a content of the interpersonal message (Col. 16 lines 44-54 "completed" as completion information).

9. Regarding claim 5, Swenson teaches a message processing apparatus:

a. Further comprising a storage unit storing the content of the interpersonal message, receivers' names and completion information indicating whether the receivers have viewed the content of the interpersonal message or whether the receivers have completed business activities related to a content of the interpersonal message, in an associated manner (Col. 8 lines 43-50);

b. Wherein the preparation unit prepares the receiver state list based on the receivers' names and the completion information (Col. 16 lines 44-54).

10. Regarding claim 6, Swenson teaches a message processing apparatus further comprising:

a. An amendment unit amending the contents of a transmitted interpersonal message stored in the storage unit (Col. 14 lines 52-67); and

b. A recovery unit recovering all the receivers' open information indicating an open state to a not-opened state when the interpersonal message is amended by the amending unit (Col. 14 lines 52-67).

11. Regarding claim 7, Swenson teaches a message processing apparatus wherein:

a. The storage unit stores a plurality of comments prepared by the receivers in response to the interpersonal message (Fig. 19 elem. 212; Col. 17 lines 8-13);

b. The recovery unit causes the comments stored in the storage unit [to] be stored without modification, when the transmitted message is amended by the amendment unit (Fig. 19 elem. 212; Col. 17 lines 8-13).

12. Regarding claim 8, Swenson teaches a message processing apparatus wherein:

a. The storage unit stores a message type of the interpersonal message (Col. 16 lines 44-54 "actions" as message type); and

b. The preparation unit prepares the receiver state list according to the message type, the receivers' names and the completion information (Col. 17 lines 1-12).

13. Regarding claim 9, Swenson teaches a message processing apparatus further comprising:

a. A setting unit displaying comment alternatives of comment patterns which correspond to the message type of the received interpersonal message, in a comment section of the received interpersonal message, and setting a comment pattern which corresponds to a comment alternative selected by the receiver as the receiver's comment to the received interpersonal message (Fig. 19 elem. 212; Col. 17 lines 8-13);

b. Wherein the storage unit includes a comment pattern storage portion for storing, corresponding to the message type, the comment patterns and the comment alternative which correspond respectively to the comment patterns (Fig. 19 elem. 212; Col. 17 lines 8-13).

14. Regarding claim 10, Swenson teaches a message processing apparatus wherein the message management unit enables a sender and all receivers of the interpersonal message to view the content of the interpersonal message and the receiver state list on screens of the terminals (Col. 18 lines 3-10).

15. Regarding claim 11, Swenson teaches a message processing apparatus wherein the message management unit provides a comment section for inputting a comment to the received interpersonal message and causes the comment inputted to the comment section to be displayed as the comment of a corresponding receiver, in the receiver state list (Fig. 19 elem. 212; Col. 17 lines 8-13).

16. Regarding claim 12, Swenson teaches a message processing apparatus wherein the message management unit causes a delay state for a response time limit that is set in the interpersonal message to be displayed as delay information in a received message list (Col. 21 lines 5-13).

17. Regarding claims 18-20, they are method claims corresponding to apparatus claim 1-3. Since they do not teach or define above the information in the corresponding apparatus claims, they are rejected under the same basis. The claims correspond as follows: 18 with 1, 19 with 2, 20 with 3.

18. Regarding claims 21-22, they are method claims corresponding to apparatus claims 1-2, respectively. Since they do not teach or define above the information in the corresponding apparatus claims, they are rejected under the same basis. Please note that

19. Regarding claims 23 and 25-27, they are computer readable media claims corresponding to apparatus claims 1-4. Since they do not teach or define above the information in the corresponding



apparatus claims, they are rejected under the same basis. The claims correspond as follows: 23 with 3, 25 with 1, 26 with 2, 27 with 4.

20. Regarding claim 24, it is a computer readable media claim corresponding to method claim 18. Since it does not teach or define above the information in the corresponding method claim, it is rejected under the same basis.

21. Claims 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Oichi, U.S. Patent No. 5,978,836.

22. Regarding claim 16, Oichi anticipates the claimed invention by disclosing an apparatus comprising:

a. A preparation unit for preparing a message list for displaying a formatted type interpersonal message related to business activities and a non-formatted type of interpersonal message not related to business activities, together with a message type (Col. 5 lines 23-37 showing email user receiving workflow message in inbox; Col. 19 lines 43-46 showing display of both workflow and nonworkflow email; Col. 19 lines 49-52 email priorities as message types);

b. A message management unit managing information in the message list (Col. 4 lines 28-35 email client).

23. Regarding claim 17, it is a method claim corresponding to apparatus claim 16. Since it does not teach or define above the information in the corresponding apparatus claim, it is rejected under the same basis.

***Claim Rejections - 35 USC § 103***

24. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

25. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson.

26. Regarding claim 15, Swenson teaches the invention substantially as claimed. See the rejection of claim 1 above. Swenson does not teach the additional limitations of claim 15. Swenson does however teach a display with an edit menu (Fig. 9 elem. 204). Official notice is hereby taken of the fact that edit menus commonly include a find option that allows for keyword searching. It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching regarding keyword searching with the system of Swenson because the resulting combination would allow a user to more efficiently find information of interest. Swenson does

not teach a system in which automatically detects designated keywords. However, this feature would have been obvious based on legal precedent that automating a manual activity is obvious. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

27. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson in view of Williams, U.S. Patent No. 5,675,733.

28. Regarding claim 13, Swenson teaches the invention substantially as claimed. See the rejection of claim 1 above. Swenson does not teach the additional limitations of claim 13.

29. Williams on the other hand teaches a workflow system that collects and displays statistical information regarding each workflow, where the system comprises:

a. An open ratio obtaining unit obtaining an open ratio of the interpersonal message from open information indicating an open state of the receiver of the interpersonal message (Col. 1 line 65 to Col. 2 line 22 indicating types of notifications; Col. 5 lines 39-47 indicating that the COD embodiment is merely exemplary of how to implement other notifications, Col. 10 lines 1-22); and

b. A display unit displaying the open ratio of the interpersonal message in a message list (Col. 11 lines 18-55).

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Williams' system for collecting and displaying statistics with the workflow system of Swenson. This combination would have been obvious based on Williams teaching that its type of display is necessary as the volume of acknowledgment messages becomes large (Col. 2 lines 23-62).

31. Regarding claim 14, Swenson teaches the invention substantially as claimed. See the rejection of claim 1 above. Swenson does not teach the additional limitations of claim 14.

32. Williams on the other hand teaches a workflow system that collects and displays statistical information regarding each workflow, where the system comprises:

a. A completion ratio obtaining unit obtaining a completion ratio from completion information indicating that the receivers of the interpersonal message have viewed the interpersonal message, or that business activities related to a content of the interpersonal message are completed (Col. 2 lines 10-15); and

b. A display unit displaying the completion ratio which is obtained from the completion ratio obtaining unit in a message list (Col. 2 lines 10-15).

33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Williams' system for collecting and displaying statistics with the workflow system of Swenson. This combination would have been obvious based on Williams teaching that its type of display is necessary as the volume of acknowledgment messages becomes large (Col. 2 lines 23-62).

#### ***Response to Arguments***

34. Applicant's arguments in the responses filed on April 28, 2002 (paper no. 13) and March 22, 2002 (paper no. 9) with respect to claims 1-27 have been fully considered but are not deemed persuasive.

35. The Applicants are arguing in substance the following: (a) Swenson does not teach a system using interpersonal messages because messages are directed to the work process model and not to a user; (b) Swenson does not teach a system using interpersonal email messages or instant-messaging messages; (c) Swenson does not teach a message management unit enabling a user to compose interpersonal messages; (d) the Examiner has

incorrectly equated a task with a message; (e) Swenson fails to teach a receiver state list because Swenson's action history list is not associated with interpersonal messages; (f) Swenson does not teach a system wherein an interpersonal message is multi-addressed; (g) the prior art of record does not teach or suggest a system that automatically counts comments to messages containing keywords; (h) Williams does not teach a system indicating whether the receivers of an interpersonal message have viewed the message, or that business related to the content of the message is completed; (i) the prior art of record does not teach or suggest the limitations of the dependent claims.

36. As to point (a), the Applicants' response filed on April 29, 2002 makes clear that the key characteristic of an interpersonal message is that it designates a particular user as the recipient. Swenson teaches that its tasks may be assigned to a particular user and that data in the corresponding messages indicates the user (Col. 2 lines 22-23; Col. 11 lines 31-35). The Applicants also argue that Swenson does not teach a system according to their invention because messages are not sent directly between users. Rather, Swenson teaches a system wherein messages are first transferred to a central server and then distributed to users. It is noted however that nothing in the claim language requires direct transmission of messages between users. Although

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

37. As to point (b), the Applicants argue that it is clear from the specification that the interpersonal messages of the claimed invention refer to interpersonal email messages or instant-messaging messages as opposed to low level interprocess communication type messages between processes. It is noted however that this limitation does not appear within the claim language. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

38. As to point (c), this argument appears to be based on the fact that Swenson includes TCL scripts within the workflow messages in order to simplify user responses. In particular, these TCL scripts may indicate the particular action taken by the user responsible for completing a particular task (Col. 2 lines 45-50). When a user selects a particular action, the system creates a message indicating which particular action was taken (Col. 17 lines 34-43, particularly lines 41-43). Nothing in the claim language requires a system to allow the user to directly

compose the message. However, even if this limitation were to appear in the claims, Swenson teaches this limitation since the user can add comments to colloquies (Fig. 9 elem. 212).

39. As to point (d), when users of the Swenson system take actions on tasks, the viewer context on the user computer sends messages to the server indicating that an action has been taken (Col. 127 lines 34-49). Clearly, Swenson implements its workflow tasks using messages.

40. As to point (e), the arguments given above with respect to point (a) explain why Swenson teaches a system using interpersonal messages.

41. As to point (f), Swenson teaches a system wherein a task may be assigned to a group (Col. 13 lines 7-12).

42. As to point (g), see the rejection of claim 15 above.

43. As to point (h), Williams distinguishes between when the a message is actually received (Col. 2 lines 10-12) versus when a node, or computer, receives an email file (Col. 2 lines 15-18). Given this distinction, a person of ordinary skill in the art at the invention was made would have reasonably inferred that Williams' first reference to actual receipt refers to when the recipient viewed the message.

44. As to point (i), the Applicants generally allege that the prior art of record fails to teach the limitations of the



dependent claims but fail to provide any discussion of the differences between the claims and the prior art of record other than what is discussed above. This general allegation of patentability does not comply with the requirements of 37 CFR 1.111(b), which requires the Applicants to point out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. After weighing the reasons for rejection given above against the lack specific reasoning in the Applicants' response, the Examiner, upon reconsideration, concludes that the dependent claims are not patentably distinguishable from the prior art of record.

### ***Conclusion***

45. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Caldwell, whose telephone number is (703) 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, Meng-Ai An, can be reached at (703) 305-9678. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses:	(703) 746-7239
After Final Responses:	(703) 746-7238
Draft Responses:	(703) 746-7240

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3900.

A handwritten signature in cursive script that reads "Andrew Caldwell".

**Andrew Caldwell**  
703-306-3036  
July 11, 2002